

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PMC Stonecare Enterprises, Inc.

Serial No. 78174944

Harvey V. McGahey of McGahey & McGahey for applicant.

Caroline Fong Weimer, Trademark Examining Attorney, Law
Office 115 (Tomas Vlcek, Managing Attorney).

Before Quinn, Hairston and Drost, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by PMC Stonecare Enterprises,
Inc. to register the mark STONE WIPES for "stone and rock
cleaning, sealing and polishing compounds in disposable
towels."¹

The trademark examining attorney refused registration
under Section 2(e)(1) of the Trademark Act on the ground
that applicant's mark, if applied to applicant's goods,

¹ Application Serial No. 78174944, filed October 16, 2002, based
on an allegation of a bona fide intention to use the mark in
commerce.

would be merely descriptive of them.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

Applicant, in urging reversal of the refusal, asserts that the Office has registered many third-party "WIPES" marks which are similar to the one sought to be registered by applicant.² Applicant contends that its mark is novel and is not used by consumers to identify applicant's product. Applicant argues as follows (Brief, p. 5):

If the applicant had requested a registration of a mark such as "stone cleaning wipes" or "stone polishing wipes," then applicant would accept the examiner's decision as well taken. However, in light of the fact that "stone wipes" is a new and novel combination not heretofore found in public use prior to the filing date of the mark, and since suggestive terminology with a trademark has not been sufficient to prevent its registration in the past, and since the Patent and Trademark Office has registered many names with similar

² Applicant has merely listed the registrations, providing the registration number, the mark registered and the date of registration. Generally, a mere listing is insufficient to make such registrations of record. *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998). The examining attorney, however, did not object to this evidence, but rather treated it as if properly made of record. The examining attorney recognizes that the registrations will be considered (Brief, p. 5, n. 2), and these registrations are deemed to be stipulated into the record. *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1513 n. 3 (TTAB 2001). They have been considered to be of record for whatever probative value they merit.

suggestiveness attributes related to the term "wipes," it is respectfully requested that the Appeals Board overturn the final decision of the Examining Attorney and allow the mark "stone wipes" to be registered.

During the prosecution of the application, applicant submitted the following disclaimer: "No claim is made to the exclusive right to use 'wipes' or 'stone' apart from the mark as shown." The examining attorney declined to enter the proposed disclaimer.

The examining attorney maintains that the mark sought to be registered clearly describes the nature of the goods, that is, cleaning and polishing wipes for stones. The individual words "stone" and "wipes" are descriptive and, according to the examining attorney, the combination of the terms is no less descriptive. The examining attorney is not persuaded by the third-party registrations, pointing out that some are registered on the Supplemental Register, and that, in any event, she is not bound by the prior decisions and actions of other examining attorneys. In support of the refusal, the examining attorney submitted a dictionary definition of the term "wipes."

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an

ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use or intended use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). It is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the

goods and services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); see also *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985). Stated another way, as the Board has explained:

....the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or services, it immediately conveys information about their nature.

In re Patent & Trademark Services Inc., 49 USPQ2d 1537, 1539 (TTAB 1998).

When two or more descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. See, e.g., *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) [SMARTTOWER merely descriptive of commercial and industrial cooling towers]; *In re Sun*

Microsystems Inc., 59 USPQ2d 1084 (TTAB 2001) [AGENTBEANS merely descriptive of computer programs for use in development and deployment of application programs]; *In re Putnam Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) [FOOD & BEVERAGE ONLINE merely descriptive of news information services for the food processing industry]; and *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) [SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays].

The term "wipe" is defined, in relevant part, as "something, such as a towel or tissue, used for wiping." (www.dictionary.com).

We find that the mark sought to be registered is merely descriptive of the nature of the goods, that is, that the goods are compound-impregnated wipes used in connection with cleaning and polishing stones. Each of the terms "stone" and "wipes" is descriptive when applied to applicant's product, and applicant appears to concede as much by its offer to disclaim each of the terms apart from the mark.³ We also find that these individual words do not somehow lose this descriptiveness in the combination STONE

³ As pointed out by the examining attorney, an entire mark may not be disclaimed. If a mark is not registrable as a whole, a disclaimer will not make it registrable. TMEP § 1213.06.

WIPES. While a combination of words may be registrable if it creates a unitary mark with a unique, nondescriptive or incongruous meaning, in this case each component of applicant's mark STONE WIPES retains its descriptive significance when used in the combination, and the combination as a whole is also merely descriptive of applicant's goods. In making this determination we note applicant's acknowledgement that "stone cleaning wipes" or "stone polishing wipes" would be merely descriptive. In this connection, we do not view the mere deletion of either of the words "cleaning" or "polishing" to magically transform STONE WIPES into an inherently distinctive mark. See *In re Abcor Development Corp.*, supra [GASBADGE is at least descriptive for "gas monitoring badge"; "the users of language have a universal habit of shortening full names--from haste or laziness or just economy of words" (Rich, J., concurring)]. When applied to the specific goods listed in the application, no imagination or speculation is required to conclude that the towels (wipes), impregnated with applicant's compound, are used to clean or polish stones.

We agree with the examining attorney's assessment that the third-party registrations are not persuasive of a different result on the issue of mere descriptiveness. The probative value of the listing supplied by applicant is

significantly diminished by the failure to also indicate the goods and/or services listed in each registration. Moreover, as pointed out by the examining attorney, some of the registrations issued on the Supplemental Register due to the descriptiveness of the subject marks. In any event, each case must be decided on its own merits, and neither the Board nor the examining attorney is bound by the prior actions of the Office. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."].

We find that the mark STONE WIPES, if used in connection with stone and rock cleaning, sealing and polishing compounds in disposable towels, would be merely descriptive as contemplated under Section 2(e)(1). The fact that applicant may be the first and/or only entity to use, or intend to use the term STONE WIPES for such goods is not dispositive where, as here, such term unequivocally projects a merely descriptive connotation. See *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994).

Decision: The refusal to register is affirmed.